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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,751	08/30/2001	Dan Stoianovici	56436(71699)	8459

21874 7590 03/03/2006

EDWARDS & ANGELL, LLP  
P.O. BOX 55874  
BOSTON, MA 02205

EXAMINER
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NGUYEN, VI X

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/943,751

Applicant(s)

STOIANOVICI ET AL.

Examiner

Victor X. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26, 29-36, 38, 39 and 42-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 44 and 45 is/are allowed.
- 6) ☒ Claim(s) 1-26, 29-36, 38, 39, 42, 43, 46 and 48-54 is/are rejected.
- 7) ☒ Claim(s) 27, 28, 40 and 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The request filed on 11/29/2005 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/943,751 is acceptable and a RCE has been established. An action on the RCE follows.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-26,29-36,38-39,42-43,46 and 48-54 are rejected under 35 U.S.C. 102 (e) as being anticipated by Madhani et al (6,786,896).

Madhani et al disclose in figures 1-3, a device for percutaneous surgery in a soft tissue target, including: a first arm (304) is configured and arranged to support the penetrating member (312), a first drive mechanism (310) is coupled to the first arm and configured to translate the first arm from an initial position to any of a number of other positions from the initial position, thereby also translating the penetrating member towards the target area, where the first arm and the first drive mechanism are coupled to the manipulation device (318). Furthermore, the first arm is configured and arranged to rotatably support the penetrating member about the longitudinal axis of the penetrating member, and where a second drive mechanism (302) is coupled to the penetrating member and arranged to cause the penetrating member to rotate about the longitudinal axis of the penetrating member (figures 2, 3, see col. 11, lines 1-7),

and where the first drive mechanism (310) includes a linear guide (inherent feature), where a second drive mechanism (302) is coupled to the penetrating member (312) and is configured to cause the penetrating member to rotate, and where the second drive mechanism comprises a gear member (see col. 12, lines 23-27) secured to the penetrating member and coupled to a motor (MO-M7)), and where a second arm (5) is coupled to the first drive mechanism (310), where the second drive mechanism is coupled to the penetrating member (312) so as to cause the penetrating member to rotate about the long axis of the penetrating member.

***Allowable Subject Matter***

3. Claims 44-45 are allowed.

Claims 27-28 and 40-41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art of record, alone or in combination, discloses all of the limitations of claims 27-28 and 40-41 including, the second drive mechanism further includes a drive gear that is mechanically coupled to the motor and the penetrating member gear member so that the penetrating member gear member rotates responsive to rotation of the drive gear, and where the motor is a bi-directional motor where the penetrating member can be rotated in one of a clockwise and counter clockwise direction responsive to the direction of rotation of the motor.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

*Response to Arguments*

4. Applicant's arguments filed 11/29/2005 have been fully considered but they are not persuasive. The applicant argues that Madhani reference fails to teach a first arm which is arranged to rotatably support a penetrating member, where a second drive mechanism is coupled to the penetrating member which is arranged to cause the penetrating member to rotate about the longitudinal axis of the penetrating member. The examiner, respectfully, disagrees. The phrase "penetrating member" in the claim is broad enough to mean that a first arm (304) is arranged to support a penetrating member (element 312 is grasped by gripper 318 and allowed element 312 to be disposed in the target area), where a second drive mechanism (302) coupled to the penetrating member and arranged to cause the penetrating member to rotate about the longitudinal axis of the penetrating member (figs. 2-3 do disclose element 312 that has some form of rotation which is capable to cause the penetrating member to rotate about the longitudinal axis of the penetrating member). Accordingly, the above noted reference is still considered to read on the claimed limitations of the claims noted.

*Conclusion*

5. This is a continuation of applicant's earlier Application No. 09/943,751. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first

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action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen  
Examiner  
Art Unit 3731

Vn VN  
2/28/2006



**JULIAN W. WOO**  
**PRIMARY EXAMINER**